

## REMARKS

By this paper, no claims are amended, added, or cancelled. Accordingly, claims 1, 3-9, 11, 12, 14-19, 22, 24-29, and 31-51 are all of the pending claims. In view of the following remarks, reconsideration and allowance of all the pending claims is anticipated.

### ***Rejections Under 35 U.S.C. § 103***

Claims 1, 3-9, 11, 12, 14-19, 22, 24-29, and 31 currently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,305,374 to Zdrojowski *et al.* ("Zdrojowski") in view of U.S. Patent Application Publication No. 2002/0026223 to Riff *et al.* ("Riff"), in further view of U.S. Patent No. 5,715,390 to Hoffman *et al.* ("Hoffman"), in still further view of U.S. Patent No. 5,725,559 to Alt *et al.* ("Alt"), and in yet still further view of U.S. Patent No. 6,504,825 to Atkins *et al.* ("Atkins"); and claims 32-51 currently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zdrojowski in view of Riff, in further view of Hoffman, in still further view of Alt, in yet still further view of Atkins, and in even further view of U.S. Patent No. 6,094,702 to Williams *et al.* ("Williams"). Applicants traverse these rejections on at least the following grounds.

It is well established that "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant."<sup>1</sup> Applicants traverse the rejection of claims 1, 3-9, 11, 12, 14-19, 22, 24-29, and 31-51 under § 103 on the grounds that the Examiner has failed to establish a *prima facie* case of unpatentability at least because (a) Riff is not prior art to claims 1, 3-9, 11, 12, 14-19, 22, 24-29, and 31-51, (b) the cited portions of the relied upon references do not teach or suggest each and every feature of the claimed invention, and (c) Hoffman is non-analogous art to claims 1, 3-9, 11, 12, 14-19, 22, 24-29, and 31-51.

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<sup>1</sup> *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468, 1472, (Fed. Cir. 1984)).

**A. Riff Is Not Prior Art.**

The Examiner acknowledges that Zdrojkowski does not teach or suggest various features recited in independent claims 1, 12, 22, 32, and 49 [the Office Action, pp. 3, 8, 9, 13, 21, and 22]. The Examiner alleges that these deficiencies of Zdrojkowski are addressed by paragraphs 22, 23, 25, and 38 of Riff. However, reliance on Riff in a rejection of claims 1, 12, 22, 32, and 49 constitutes legal error because the sections of Riff relied on in the Office Action are not prior art to these claims.

The instant application was filed December 10, 2001, but claims priority under 35 U.S.C. § 119(e) from provisional U.S. patent application no. 60/256,021 (the "021 Application"), which was filed December 15, 2000. Claims 1, 12, 22, 32, and 49 are supported for the purposes of 35 U.S.C. § 112 by the disclosure of the '021 Application as filed on December 15, 2000. As such, claims 1, 12, 22, 32, and 49 are entitled to a priority date of December 15, 2000.

Riff was filed on December 18, 2000. Riff claims priority under § 119(e) from provisional U.S. patent application no. 60/173,062 (the "062 Application"), which was filed December 24, 1999. However, paragraphs 22, 23, 25, and 38 of Riff are not included in the '062 Application. As such, paragraphs 22, 23, 25, and 38 are not afforded the filing date of the '062 Application, but instead have a priority date of December 18, 2000 (the filing date of Riff).

Since the priority date of claims 1, 12, 22, 32, and 49 predates the priority date of paragraphs 22, 23, 25, and 38 of Riff, these sections of Riff are not prior art for the purposes of claims 1, 12, 22, 32, and 49. Thus, reliance on paragraphs 22, 23, 25, and 30 of Riff in the rejections of independent claims 1, 12, 22, 32, and 49 under § 103(a) constitute legal error. Further, the sections of Hoffman, Alt, Atkins, and/or Williams relied on in the Office Action do not address the acknowledged deficiencies of Zdrojkowski for which paragraphs 22, 23, 25, and 30 of Riff were previously cited. For at least this reason, the rejections of independent claims 1, 12, 22, 32, and 49 constitute legal error and must be withdrawn.

Claims 3-9, 11, 14, 19, 24-29, 31, 33-48, 50, and 51 depend from a corresponding one of claims 1, 12, 22, 32, and 49. As such, the rejection of claims 3-9, 11, 14, 19, 24-29, 31, 33-48, 50, and 51 based on the proposed combinations of Zdrojkowski, Riff, Hoffman, Alt, Atkins, and/or Williams must be withdrawn due to the dependency of these claims, as well as for the features that they recite individually.

**B. The Proposed Combination Of References Does Not Teach Or Suggest All Of The Features Of The Claimed Invention.**

In order to establish a *prima facie* case of unpatentability the Examiner must show that the references teach or suggest all of the features of the claimed invention.<sup>2</sup> In establishing that the references teach or suggest all of the features of the claimed invention, all of the actual words in the claim must be considered.<sup>3</sup> The rejections of claims 1, 3-9, 11, 12, 14, 19, 22, 24-29, and 31-51 constitute legal error at least because the Examiner has not demonstrated that the proposed combinations of Zdrojkowski, Riff, Hoffman, Alt, Atkins, and/or Williams teach or suggest each and every feature of the claimed invention.

For example, independent claim 1 recites *inter alia* the following features that are not taught or suggested in the sections of Zdrojkowski, Riff, Hoffman, Alt, and Atkins relied on in the Office Action:

...maintaining a database for a plurality of pressure generating systems external to the pressure support systems, wherein the database includes [] a serial number unique to each pressure generating system in the plurality of pressure systems...; and

updating the database by assigning a new serial number for an upgraded pressure generating system. Emphasis added.

Independent claim 12 recites *inter alia* the following features:

...a database for a plurality of pressure generating systems, wherein the database includes [] a serial number unique to each pressure generating system in the plurality of pressure systems, ...and wherein the database is updated to assign a new serial number for an upgraded pressure generating system. Emphasis added.

<sup>2</sup> *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

<sup>3</sup> *In re Wilson*, 424 F.2d 1362, 1385 (C.C.P.A. 1970).

Independent claim 22 recites *inter alia* the following features:

... a database for a plurality of pressure generating systems, wherein the database includes [] a serial number unique to each pressure generating system in the plurality of pressure systems, ...and wherein the database is updated to assign a new serial number for an upgraded pressure generating system. Emphasis added.

Independent claim 32 recites *inter alia* the following features:

...updating the database to indicate that the pressure generating system having the first serial number has been upgraded with the desired upgrade by assigning a new serial number of an upgraded pressure generating system. Emphasis Added.

Independent claim 49 recites *inter alia* the following features:

...updating the database to indicate that the pressure generating system has been upgraded with the desired upgrade by assigning a new serial number for an upgraded pressure generating system. Emphasis Added.

The Examiner acknowledges that Zdrojkowski, Riff, Hoffman, Alt, and Williams do not teach or suggest these features [the Office Action, p. 5]. However, the Examiner alleges that these deficiencies are addressed by the teachings of Atkins at column 1, line 62 through column 2, line 6. This section of Atkins reads as follows:

Universal unique identifiers (UUIDs) are well known in the PC industry. Each data processing system has a unique UUID which may be its serial number or other set of characters. Utilizing the UUIDs, each data processing system may be uniquely identified. As with the IP address, however, the UUID associated with a particular data processing system identifies the data processing system, but not its physical location. If a data processing system is moved, determining its physical location at a later date requires a manual search.

At best, this section of Atkins teaches identifying individual pieces of electronic equipment with a single unique identifier and then using the previously assigned unique identifier in an ongoing and perpetual manner. By contrast, the portions of independent claims 1, 12, 22, 32, and 49 reproduced above not only include databases having “a serial number unique to each pressure generating system,” and also involve “assigning a new serial number” to one of the “pressure generating systems” in the database if it is

upgraded. The section of Atkins relied on in the Office Action does not disclose the upgrading of identified electronic equipment, or the assignment of a new unique identifier to a previously identified piece of equipment. Therefore, the sections of Atkins relied on in the Office Action do not address the acknowledged deficiencies of Zdrojkowski, Riff, Hoffman, Alt, and Williams. As such, the proposed combinations of Zdrojkowski, Riff, Hoffman, Alt, Atkins, and/or Williams do not teach or suggest at least the features of independent claims 1, 12, 22, 32, and 49 reproduced above. For at least this reason, the rejections of independent claims 1, 12, 22, 32, and 49 constitute legal error and must be withdrawn.

Claims 3-9, 11, 14, 19, 24-29, 31, 33-48, 50, and 51 depend from a corresponding one of claims 1, 12, and 22. As such, the rejection of claims 3-9, 11, 14, 19, 24-29, 31, 33-48, 50, and 51 based on the proposed combination of Zdrojkowski, Riff, Hoffman, Alt, and Atkins must be withdrawn due to the dependency of these claims, as well as for the features that they recite individually.

**C. Hoffman Is Non-Analogous Art To Claims 1, 3-9, 11, 12, 14-19, 22, 24-29, And 31-51.**

*Graham v. Deere* dictates that in establishing a *prima facie* case of obviousness, first the scope and content of the prior art must be determined.<sup>4</sup> This includes determining what constitutes analogous art. If a reference is determined not to constitute analogous art, it can not be further considered in the obviousness analysis.

The Examiner's reliance on Hoffman for the rejection of claims 1, 3-9, 11, 12, 14, 19, 22, 24-29, and 31-51 constitutes legal error, as this reference is non-analogous art to Applicants' claimed invention.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is "within the field of the inventor's endeavor." Second, assuming

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<sup>4</sup> 383 U.S. 1 (1966).

the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved."<sup>5</sup>

A. Hoffman Is Outside Applicants' Field Of Endeavor.

Hoffman is outside the field of the inventor's endeavor for at least the reason that Hoffman does not relate to the relevant field of endeavor. The inventor's field of endeavor (for claims 1, 3-9, 11, 12, 14, 19, 22, 24-29, and 31-51) relates to upgrading the operating features of medical devices [the specification ¶ 2].

Hoffman, by contrast, clearly states that the field of endeavor is the activation of options in electricity meters [the Title, the Abstract, and c. 1, ll. 6-10]. This field of endeavor is not within the inventor's field of endeavor.

B. Hoffman Is Not Reasonably Pertinent To The Particular Problem(s) With Which Applicants Were Involved.

Since Hoffman is outside the inventor's field of endeavor, the inquiry becomes whether this reference is reasonably pertinent to the particular problem(s) with which Applicants were involved.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would commend itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has **the same purpose** as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.<sup>6</sup>

Hoffman is not reasonably pertinent to the particular problem(s) with which Applicants were involved. These problems include, for example, the stringent regulatory issues associated with medical equipment (*e.g.*, FDA regulation, *etc.*), patient

<sup>5</sup> *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986).

<sup>6</sup> *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992) (emphasis added).

comfort and compliance concerns, and other issues specific to the field of medical device technology.

Hoffman, however, is more concerned with the problem of activating options in electrical meters. The electrical meters which were the focus of the Hoffman are generally installed in low traffic areas, and are not subject to anywhere near the same regulatory, aesthetic, convenience and other concerns associated with medical devices [Hoffman, c. 1, ll. 6-10, and c. 1, l. 62-c. 2, l. 15].

The Examiner provides only a conclusory statement that the concept for upgrading an electrical meter allegedly taught in the cited sections of Hoffman "is the [sic] similar to the claimed invention," and that "the concept of securely upgrading a device or controller in Hoffman can be applied to a variety of devices and machines" [the Office Action, p. 4].

The supposed similarity between the technique of Hoffman and the claimed invention are not relevant to the determination of whether Hoffman constitutes analogous art to the claimed invention. The statement by the Examiner that the teachings of Hoffman could be "applied to a variety of devices and machines" is not evidence, but a conclusion. Absolutely no actual evidence has been provided that a person having ordinary skill in the art would reasonably have expected to solve the problem(s) associated with upgrading features of medical devices by considering the problem(s) addressed by Hoffman. As such, the Examiner has failed to demonstrate that one of ordinary skill in the art would look to the diverse field of Hoffman absent hindsight.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor... [I]t is...in other words, common sense...in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs

the applicant's only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.<sup>7</sup>

Application of the proper two-step legal analysis frequently demonstrates that references, which might appear relevant to (or have something in common with) a claimed invention, are not analogous and therefore may not be properly considered. The Federal Circuit has frequently confirmed this. For example, it has held that the art of petroleum extraction is not analogous to the art of petroleum storage despite both being in the petroleum industry.<sup>8</sup> Fasteners for garments are not analogous to fasteners for a hose clamp.<sup>9</sup> Paper stapling is not analogous to surgical stapling.<sup>10</sup> Single in-line memory modules (SIMMs) for an industrial controller are not analogous to SIMMs for personal computers.<sup>11</sup> Railway car brakes are not analogous to automotive vehicle brakes.<sup>12</sup>

For at least the foregoing reasons, it is clear that the Examiner has not proven an essential element of the obviousness test, *i.e.*, that Hoffman is within the scope and content of the prior art. As a result, Hoffman cannot be properly considered in an obviousness analysis. "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness."<sup>13</sup> This reference therefore cannot be relied upon to prove obviousness of Applicants' invention as claimed in any of claims 1, 3-9, 11, 12, 14, 19, 22, 24-29, and 31. Accordingly, the rejection of claims 1, 3-9, 11, 12, 14, 19, 22, 24-29, and 31 under 35 U.S.C. § 103(a) based on the proposed combination of Zdrojowski, Riff, Hoffman, Alt, and Atkins must be withdrawn.

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<sup>7</sup> *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

<sup>8</sup> *In re Clay*, 966 F.2d 856, 859-60 (Fed. Cir. 1992).

<sup>9</sup> *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

<sup>10</sup> *U.S. Surgical Corp. v. Hospital Prods. Int'l Pty., Ltd.*, 701 F. Supp. 314, 334 (D. Conn. 1988).

<sup>11</sup> *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1992).

<sup>12</sup> *SAB Industri AB v. The Bendix Corp.*, 199 USPQ 95, (E.D. Va. 1978).

<sup>13</sup> *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).



## **CONCLUSION**

Having addressed each of the foregoing objections and rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is anticipated.

It is believed that no extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 14-1270 (Ref. No. 011142US2).

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: February 23, 2009

Respectfully submitted,

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Note: The Commissioner is authorized to charge any fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 14-1270.